

## REMARKS

Claims 1-7 are pending in the present application. By this Response, Applicant has amended claims 3, 4 and 7, and has added new claims 8-14. Applicant respectfully submits no new matter was added by the Amendments, and that the Amendments are fully supported by the specification. Specifically, regarding new claims 8-14, the Summary of the Invention of the present application indicates the system can query more than one device in an industrial control system (e.g., at p. 2, lines 11-12 “. . . querying the devices to have each device indicate its component hardware . . .”). Moreover, multiple devices (22 and 26) are shown in Figure 1. Accordingly, claims 1-14 are at issue.

The Examiner has reopened prosecution in view of the Appeal Brief filed by the Applicant in response to the final Office Action of February 9, 2004 (Paper No. 13), and has issued a non-final Office Action of October 19, 2004. The Office Action of October 19, 2004 does not include the rejections set forth in the Office Action of February 9, 2004. Accordingly, Applicant submits those rejections have been withdrawn and are now moot.

The Examiner has rejected claims 1-3 and 5-7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication 2002/0029086 (“Ogushi”) in view of U.S. Patent No. 6,230,199 (“Revashetti”). Applicant respectfully traverses this rejection.

The invention of claim 1 is for a system for remote configuration monitoring of an industrial control system. The industrial control system includes one or more automation or control devices. The automation or control devices include components such as hardware, software and firmware. The system of claim 1 requires, among other limitations, “a device

identifier for determining components of an automation or control device (26) included in the industrial control system (20)” and “a device configuration manager (36) . . . for comparing the installed device components with the available device components,” wherein the device components are of the automation or control device.

Neither Ogushi or Revashetti, alone or combined, disclose the invention of claim 1. Moreover, the combination of Ogushi and Revashetti is improper because there is no incentive or motivation to combine the references in the manner suggested by the Examiner, and the Examiner improperly used hindsight reconstruction in making the combination.

Ogushi discloses a system for providing remote maintenance of industrial equipment. As acknowledged by the Examiner, Ogushi fails to teach:

a device identifier periodically querying the device (26) to obtain from the device (26) information identifying at least some of its component hardware, software, and firmware, the device identifier for providing a device database (33) with component identifications for the device (26); and a device configuration manager (36), responsive to the component identifications in the device database (33), and further responsive to available device components in a database (34) of available device components, for comparing the installed device components with the available device components and for providing an offer to upgrade installed device components. (Office Action of October 19, 2004, p. 3).

Revashetti discloses a system for marketing products and services to a user of client computer. Revashetti does not teach or suggest the system of claim 1. Specifically, Revashetti fails to disclose: (1) an industrial automation system; (2) an automation or control device; (3) a device identifier for determining components of an automation or control device; (4) periodically querying an automation or control device; (5) a device database with component identifications for an automation or control device; (6) a device configuration manager responsive to a database with component identifications for an automation or control device; (7) a device configuration

manager further responsive to a database of available components of an automation or control device; (8) a device configuration manager for comparing components installed in an automation or control device with available components for an automation or control device; and (9) a device configuration manager that provides an offer to upgrade components installed in an automation or control device.

The combination of Ogushi with Revashetti is improper because there is no motivation or incentive in the prior art to combine these references in the manner suggested by the Examiner. See *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Here, there is absolutely no incentive in the “admitted prior art” or the cited references to combine the “admitted prior art” and the references in the manner suggested by the Examiner. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986).

In the present case, the Examiner fails to show an incentive or motivation to combine the references. Instead, the Examiner only asserts:

[t]herefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the marketing system of Revashetti with the industrial system of Ogushi because it would provide for the purpose of marketing software, hardware, and related products to users of computer systems based upon

the user's current computer environment configuration. (Office Action of October 19, 2004, p. 4).

The Examiner must go further than simply concluding it would have been obvious to combine the cited references. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP 2143.01. Second, there must be a reasonable expectation of success. See MPEP 2143.02. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. See MPEP 2143.03. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner bears the initial burden on factually supporting any *prima facie* conclusion of obviousness. See MPEP § 2142. In the present case, the Examiner failed to meet this burden.

The Examiner did not make any showing that a motivation or incentive to combine existed in the references themselves or anywhere else in the prior art. Further, the Examiner made no attempt to show any reasonable expectation of success of the suggested combination. Finally, as described above, the combined references do not disclose each of the limitations of the claimed invention. Instead, the Examiner attempts to entirely recreate the system disclosed in Ogushi to implement and include features of Revashetti. Moreover, the Examiner is not just cutting and pasting the features Revashetti into the system of Ogushi, but is also modifying those features to fit the parameters of an industrial control system and automation or control devices.

It is apparent the Examiner has taken isolated features from the cited references, and has used the claims of the present application as a template. Such hindsight reconstruction is improper. It is well-recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed device obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); *Fine*, 837 F.2d at 1075 (“one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.”).

Accordingly, in view of the above arguments, Applicant respectfully submits claim 1 is patentable over Ogushi in view of Revashetti. Claims 2-3 and 5-7 depend on claim 1, either directly or indirectly, and include each of its limitations. Therefore, Applicant respectfully submits claims 2-3 and 5-7 are also patentable over Ogushi in view of Revashetti.

The Examiner has rejected claim 4 under 35 U.S.C. §103(a) as being unpatentable over Ogushi in view of Revashetti and further in view of U.S. Patent No. 6,122,639 (“Babu”). Applicant respectfully traverses this rejection.

As set forth above, Applicant submits claim 1 is patentable over Ogushi in view of Revashetti. The addition of Babu does not effect the analysis of claim 1. Claim 4 depends on claim 1 and includes each of its limitations. Accordingly, Applicant respectfully submits claim 4 is patentable over Ogushi in view of Revashetti and further in view of Babu.

Applicant submits the reasons given above with respect to claims 1-7 apply as well to new claims 8-14, and that new claims 8-14 are also patentable over the cited references.

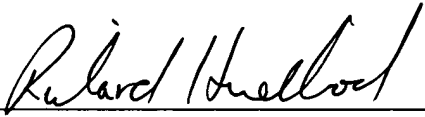
**CONCLUSION**

In light of the foregoing Amendments and Remarks, Applicant respectfully submits pending claims 1-14 are in condition for allowance, and respectfully requests reconsideration and allowance of claims 1-7, and consideration and allowance of claims 8-14. The Examiner is invited to contact the undersigned if there are any questions concerning this Response.

The Commissioner is authorized to debit or credit Deposit Account No. 23-0280 for any payment **deficiencies or overpayments** associated with this matter.

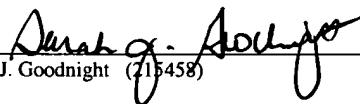
Respectfully submitted,

Dated: December 20, 2004

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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on December 20, 2004.

  
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